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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,002	02/20/2004	Fuhwei Lwo	RSW920030291US1	7441

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EXAMINER	
CHEN, QING	

ART UNIT	PAPER NUMBER
2191	

NOTIFICATION DATE	DELIVERY MODE
07/16/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/783,002	**Applicant(s)** LWO, FUHWEI	
	Examiner Qing Chen	**Art Unit** 2191	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: 1-27.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

/Wei Y Zhen/
Supervisory Patent Examiner, Art Unit 2191

Continuation of 11. does NOT place the application in condition for allowance because:

Regarding the Applicant's arguments on page 11 to page 13 of the "Remarks" pertaining to the rejections of the claims made under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103(a), the Applicant first asserts that the term JAVA has a definite meaning and its use in the claims is permitted. Applicant also asserts that the cited references fail to teach or suggest comparing the loaded classes to identify APIs that have been modified between the first release of Java byte code and the second release of the Java byte code, wherein an API has not been modified in case that it maintains a same name, parameter order, parameter types and return types in both the first release of the Java byte code and the second release of the Java byte code. Applicant also asserts that the passages in Schwabe refer to different functions of Schwabe that are completely unrelated. Lastly, the Applicant also asserts that the passages in Schwabe cited by the Office do not teach that the class files that are loaded are class files that are derived from the matching. Applicant's arguments are fully considered but found to be not persuasive for at least the following reasons:

First, with respect to the Applicant's assertion that the term JAVA has a definite meaning and its use in the claims is permitted, as previously pointed out in the Final Rejection (mailed on 05/02/2008) and the Non-Final Rejection (mailed on 10/20/2008) and further clarified hereinafter, the Examiner respectfully submits that, according to MPEP § 2173.05(u), if the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Id. The trademark JAVA is used in the claims to describe a particular programming language. It refers to a specific product that is proprietary to Sun Microsystems. When a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. Id. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name. Id. Furthermore, MPEP § 608.01(v) provides guidelines on the use of trademarks in patent specifications and thus, does not pertain to the use of trademarks in the claims.

Second, with respect to the Applicant's assertion that the cited references fail to teach or suggest comparing the loaded classes to identify APIs that have been modified between the first release of Java byte code and the second release of the Java byte code, wherein an API has not been modified in case that it maintains a same name, parameter order, parameter types and return types in both the first release of the Java byte code and the second release of the Java byte code, as previously pointed out in the Non-Final Rejection (mailed on 10/20/2008) and the Final Rejection (mailed on 04/16/2009) and further clarified hereinafter, the Examiner respectfully submits that Schwabe clearly discloses "comparing the loaded classes to identify APIs that have been modified between the first release of byte code and the second release of the byte code, wherein an API has not been modified in case that it maintains a same name, parameter order, parameter types and return types in both the first release of the byte code and the second release of the byte code" (see Figure 2; Column 25: 50-53, "… the class and interface attributes are compared to the attributes of the same class or interface in the new package. The attributes may include the name, flags, number of fields and number of methods."; Column 26: 1-10, "At 1650, for each field in the old package, the attributes are compared to the same field in the new package. The attributes may include the name, flags and type." and "At 1655, for each method in the old package, the attributes are compared to the same method in the new package. The attributes may include the name, flags and signature."). Attention is drawn to Figure 2 of Schwabe which clearly illustrates that within the JVM, the loader first loads the class files and then the verifier verifies the loaded class files. Thus, one of ordinary skill in the art would readily comprehend that the verification process illustrated in Figure 20D occurs after the loading of the class files to compare the package attributes of the new API definition file and the old API definition file.

Third, with respect to the Applicant's assertion that the passages in Schwabe refer to different functions of Schwabe that are completely unrelated, as previously pointed out in the Non-Final Rejection (mailed on 10/20/2008) and the Final Rejection (mailed on 04/16/2009) and further clarified hereinafter, the Examiner respectfully submits that, in the drawing figure and passages cited by the Examiner, Schwabe describes class loading and verification in the JVM, which is well-known to those of ordinary skill in the art. In the JVM, a loader loads a class file prior to a verifier verifies it. Thus, one of ordinary skill in the art would readily comprehend that loading of class files occurs first in the JVM and then, the verifier verifies the loaded class files. Therefore, the loading process and the verification process are related processes in the JVM.

Fourth, with respect to the Applicant's assertion that the passages in Schwabe cited by the Office do not teach that the class files that are loaded are class files that are derived from the matching, as previously pointed out in the Non-Final Rejection (mailed on 10/20/2008) and the Final Rejection (mailed on 04/16/2009) and further clarified hereinafter, the Examiner respectfully submits that Schwabe clearly discloses "loading classes corresponding to the matching class names" (see Figure 2; Column 4: 1-10, "In the JVM, the loading step retrieves the class file representing the desired class."; Column 5: 23-27, "When the binary file 60 is referenced by an application executing on a virtual machine 65, a loader 70 loads the binary file 60. A verifier 75 verifies the binary file 60 at some point prior to execution by an interpreter 80."). Note that, as clarified hereinabove, the verification process occurs after a class file is loaded. Thus, after matching the set of classes and interfaces between the old API definition file and the new API definition file occurs, the matching set of classes and interfaces are loaded to be verified by the verifier.

Therefore, for at least the reasons set forth above, the rejections made under 35 U.S.C. § 112, second paragraph, with respect to Claims 3-6 and 9 and the rejections made under 35 U.S.C. § 103(a) with respect to Claims 1, 10, and 19 are proper and therefore, maintained.

Continuation of 13. Other: The objection to the abstract is withdrawn in view of Applicant's arguments.